

REMARKS

Claims 1-17 are pending in the present application. New claims 18-26 have been added.

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action. Applicants respectfully submit that the claims are patentable over the cited references for at least the reasons set forth below. Reconsideration of the application is hereby requested.

The Examiner has rejected claims 1-17 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,176,103 to Cruden et al. in light of U.S. Patent No. 5,102,936 to Huth et al. The Examiner cites the Cruden et al. patent as showing a polymer latex useful in coating and binder compositions, wherein the polymer latex is derived from carbonyl-containing monomers, such as diacetone acrylamide. The Examiner cites the Huth et al. patent as showing a copolymer dispersion useful as a thickener, wherein the copolymer dispersion is derived from ethylenically unsaturated monomers that comprise a macromonomer of surface-active urethane derivatives and 0-5 weight percent of carbonyl-containing monomers. The Examiner asserts that it would have been obvious to one having ordinary skill in the art to use the copolymer dispersion of the Huth et al. patent as a thickener in the aqueous system of Cruden et al. Applicants respectfully disagree.

In the Huth et al. patent, the copolymer dispersion is disclosed as being synthesized from monomers including (with emphasis added) “0 to 5% by weight of ethylenically unsaturated carbonyl compounds..” The recitation of “0” clearly shows that the Huth et al. patent considers the carbonyl-containing monomers to be optional and not required by the invention. This is confirmed by the examples of the Huth et al. patent, which fail to show any copolymer dispersions being synthesized from carbonyl-containing monomers. Accordingly, Applicants submit that the Huth et al. patent does not disclose a copolymer synthesized from carbonyl-containing monomers with sufficient specificity to show the component (b) of independent

claims 1 and 8. For at least this reason, Applicants submit that independent claims 1 and 8 are patentable over the Cruden et al. patent and the Huth et al. patent.

In addition to not showing component (b), Applicants submit that there is no motivation to combine the copolymer dispersion of the Huth et al. patent with the polymer latex of the Cruden et al. patent. Applicants submit that the mere fact that the copolymer dispersion of the Huth et al. patent and the polymer latex can both be used in coatings is not sufficient motivation to combine the two references. In the case of In re Geiger, 2 USPQ2d, 1277 (Fed. Cir. 1987), the Federal Circuit was presented with a rejection of a method claim for inhibiting scale formation on and corrosion of metallic parts in cooling water systems. The rejection was based on three patents showing three different components of the method claim. All three components were used for treating cooling water systems. The fact that all three components were known for use in cooling water systems, however, did not provide sufficient motivation to combine the three patent references, according to the Federal Circuit. In holding that the Examiner failed to establish a prim facie case of obviousness, the Federal Circuit stated (with emphasis added):

“At best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations of these known scale and corrosion prevention agents. However, this is not the standard of 35 U.S.C. §103.”

Based on In re Geiger, Applicants submit that there is no motivation to combine the copolymer dispersion of the Huth et al. patent with the polymer latex of the Cruden et al. patent. For at least this reason, Applicants submit that independent claims 1 and 8 are patentable over the Cruden et al. patent and the Huth et al. patent.

For at least the foregoing reasons, Applicants submit that independent claims 1 and 8 are patentable over the cited references. Applicants consider it apparent that claims 2-7 and 9-17 are also patentable over the cited references because they depend from claim 1 or claim 8 and recite additional novel features of the present invention.

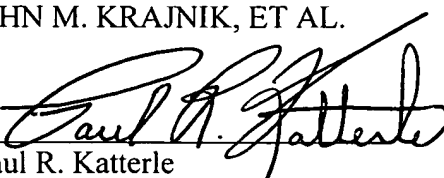
In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance,

the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Respectfully submitted,

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June 3, 2002
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